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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/619,472

07/16/2003

David S. Rathbun

8932-767

7370

51832

7590

03/26/2007

JONES DAY

222 EAST 41ST STREET

NEW YORK, NY 10017-6702

EXAMINER

REIMERS, ANNETTE R

ART UNIT

PAPER NUMBER

3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/26/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/619,472

Applicant(s)

RATHBUN ET AL.

Examiner

Annette R. Reimers

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-13, 15-18, 20 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-13, 15-18 and 25-30 is/are rejected.
- 7) ☒ Claim(s) 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6, 7, 9-12, 18 and 25-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Caspar et al. (US Patent Number 5,669,915), cited by applicant on 1449, paper number 12022004.

Caspar et al. disclose a surgical drill guide assembly comprising an outer stem having a bore and a longitudinal axis, a drill guiding barrel attached to the outer stem, wherein the drill guiding barrel is movably attached to the outer stem at a substantially fixed angle with respect to the outer stem, a threaded rod, e.g. 7, having a non-circular cross-section at one end releasably attached to the outer stem and a bone plate, e.g. 29, and a release mechanism with a non-circular passage, e.g. 22 (see figures 1 and 3). The surgical drill guide assembly further comprises a handle member offset from the stem by an offset handle arm, e.g. 4, (see figure 1). A ball detent is located in the stem and a groove is located on the rod (see figure 4). The drill guide barrel pivots about a hinge (see figure 4) on the stem and the drill guide barrel has a depth stop, e.g. 8 (see figure 2).

With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Caspar et al, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claims 6-8, 10, 13, 15-16, 18 and 25-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Brace et al. (US Patent Number 6,342,057), cited by applicant on 1449, paper number 12022004.

Brace et al. discloses a surgical drill guide assembly comprising an outer stem, e.g. 206, having a bore, e.g. 208, and a longitudinal axis, drill guiding barrels, e.g. 134 and 136, are attached to the outer stem, wherein the drill guiding barrel is movably attached to the outer stem at a substantially fixed angle with respect to the outer stem, a rod, e.g. 204, releasably attached to the outer stem and a bone plate, e.g. 254, and a release mechanism, at 278 and 280 (see figures 1-2, 6-10, 12 and 14-19). The surgical drill guide assembly further comprises a handle member, e.g. 112, offset from the stem by an offset handle arm, e.g. 114, wherein the handle member pivots in relation to the offset handle arm (see figures 1 and 3-5). The rod has a non-circular cross-section at

Art Unit: 3733

one end (see figures 14 and 15). The drill guide barrel pivots about a hinge on the stem and the drill guide barrel has a depth stop (see figures 2, 6-8, 10 and 16-19 and column 11, lines 55-64).

With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Brace et al., which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brace et al. (US Patent Number 6,342,057), cited by applicant on 1449, paper number 12022004.

Brace et al. disclose the claimed invention except for the multiple insertion passageways having angular orientations of about 0° to about 10° toward the longitudinal axis of a bone plate and about 75° to about 90° upward or downward to the longitudinal axis of a bone plate. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Brace et al. with the multiple insertion passageways having angular orientations of about 0° to about 10° toward the longitudinal axis of a bone plate and about 75° to about 90° upward or downward to the longitudinal axis of a bone plate, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

#### ***Allowable Subject Matter***

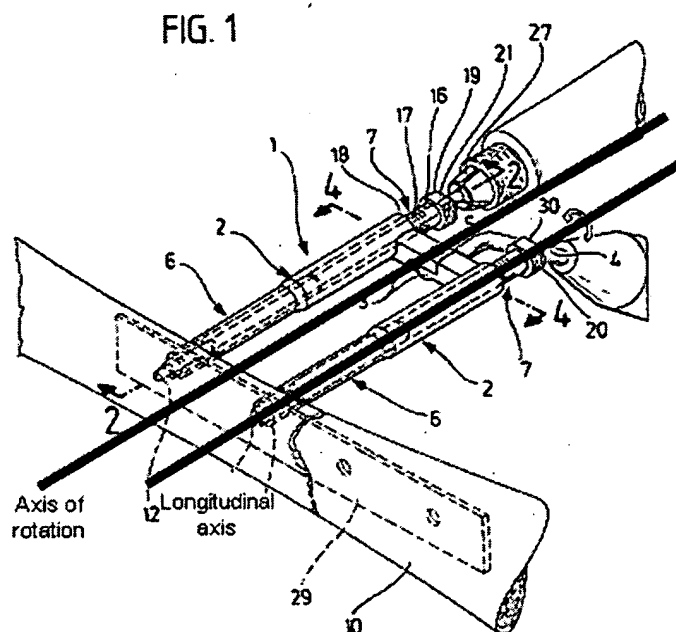
Claim 20 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

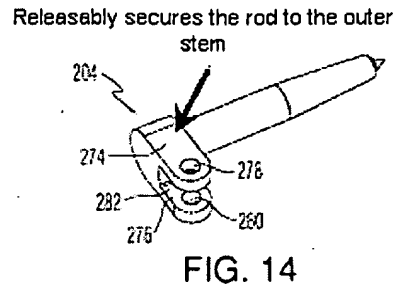
Applicant's arguments filed on December 20, 2006 have been fully considered, but they are not persuasive. Examiner respectfully disagrees with applicant regarding the Caspar et al. reference. Regarding claims 6 and 28, the drill guide barrel is at a substantially fixed angle with respect to the outer stem when the two are stationary. Applicant is claiming "movably attached" and "a substantially fixed angle" i.e., capable of moving and at a substantially fixed angle not moving while at a fixed angle. In addition, regarding claim 25, the outer stem has a first longitudinal axis and the drill guiding barrel

Art Unit: 3733

is pivotable about an axis of rotation substantially parallel to the first longitudinal axis (see figure 1 below).



Examiner also respectfully disagrees with applicant regarding the Brace et al. reference. Regarding claims 6, 25 and 28 the rod, e.g. 204, is releasably secured to the outer stem, e.g. 206 (see figure 14 below).



### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.



Art Unit: 3733


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER